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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/648,314

Filing Date: August 25, 2000

Appellant(s): GREGOV ET AL.

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Steven D Lawrenz  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 3/18/2008 appealing from the Office action mailed

11/9/2007

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,412,012	Bieganski	6-2002
5,616,876	Cluts	4-1997

6,850,899	Chow et al	2-2005
5,897,650	Nakajima et al	4-1999

## **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 15, 16, 27-31, 45 and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,412,012 (Bieganski et al), hereafter Bieganski.

#### **Claims 15, 16, 27-31, 45 and 48:**

Bieganski discloses:

**receiving requests from the user to display information about each of a plurality of items**

[shopping set 202, Fig 2, col 7, line 65 through col 8, line 15,

Bieganski discloses: “A shopping set 202 includes items for which the user has indicated a current intent to purchase or consume. Examples of ways that a shopping set can be generated include, but are not limited to using the contents of a market basket from the Internet-based

shopping service, using the set of items entered into a cash register at check-out time, using a shopping list provided by the customer”]

Examiner Notes: shopping set 202 anticipates the claimed “plurality of items”

**selecting as seed items the plurality of items that were displayed**

[shopping set 202, Fig 2, col 7, line 65 through col 8, line 15,

Bieganski discloses: “It is advantageous to use a shopping set when the value of recommendations provided to the user can be increased based on the compatibility with products currently being purchased. Hence a cooking store might use the shopping set at check-out to identify items for suggestive selling, such as a Chinese cookbook for customers purchasing a Wok.”]

Examiner notes: products currently being purchased anticipates the claimed “seed items”

**generating a list of recommended items using the selected seed items, wherein the generated list does not contain the selected seed items**

[recommendation set 201, Fig 2, col 8, 7, lines 10-15,

Bieganski discloses “It is advantageous to use a shopping set when the value of recommendations provided to the user can be increased based on the compatibility with products currently being purchased. Hence a cooking store might use the shopping set at check-out to identify items for suggestive selling, such as a Chinese cookbook for customers purchasing a Wok.”]

Examiner notes: identify items for suggestive selling anticipates the claimed “list of recommended items.”

**displaying the generated list of recommended items to the user** [col 6, line 67 – col 7, line 1, the display adapter 112 may be connected to a display 116 for displaying a recommendation to a user. display 116, Fig 1]

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bieganski as applied to claim 27 above, and further in view of US Pat No 5,616,876 (Cluts), hereafter Cluts.

**Claim 32:**

Bieganski discloses the elements of the claimed invention as noted above but does not disclose wherein a distinguished one of the product groups comprises products that are recordings of a single artist, and wherein the information displayed for the distinguished product group describes the artist. Cluts discloses wherein a distinguished one of the product groups comprises products that are recordings of a single artist, and wherein the information displayed for the distinguished product group describes the artist [col 12, lines 45-50]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bieganski to include wherein a distinguished one of the product groups comprises products that are recordings of a single artist, and wherein the information displayed for the distinguished product group describes the artist as taught by Cluts for the purpose of adding new songs to a current playlist [abstract]

**Claim 33:**

The combination of Bieganski discloses the elements of the claimed invention as noted above and furthermore discloses wherein a distinguished one of the product groups comprises products that are books written by a single author, and wherein the information displayed for the distinguished product group describes the author [Bieganski; col 5, lines 20-25]

Claim 34:

The combination of Bieganski discloses the elements of the claimed invention as noted above and furthermore discloses wherein the control displayed for a distinguished product group is a button that is selected by the user by clicking the button [Cluts; Fig 5]

Claims 40-42, 46, 47 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bieganski as applied to claim 15 above, and further in view of US Pat No 6,850,899 (Chow et al), hereafter Chow.

Claims 40, 46 and 49:

Bieganski discloses the elements of the claimed invention as noted above but does not disclose removing an item from the plurality of items selected as seed items in response to a request from the user. Chow discloses removing an item from the plurality of items selected as seed items in response to a request from the user [Fig 3]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bieganski to include removing an item from the plurality of items selected as seed items in response to a request from the user as taught by Chow for the purpose of removing an item which the shopper considers too expensive.

Claims 41, 42 and 47:

The combination of Bieganski and Chow discloses the elements of the claimed invention as noted above but does not disclose adding an item to the plurality of items selected as seed items in response to a request from a user [abstract]

Claims 43 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Bieganski and Chow as applied to claim 42 above, and further in view of Cluts.

Claim 43 and 50:

The combination of Bieganski and Chow discloses the elements of the claimed invention as noted above but does not disclose wherein the control is a button that is selected by the user clicking the button. Cluts discloses wherein the control is a button that is selected by the user clicking the button [Fig 5]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination of references to include Cluts discloses wherein the control is a button that is selected by the user clicking the button as taught by Cluts for the purpose of activating the selection.

Claims 35 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Bieganski as applied to claim 27 in view of US Pat No 5,897,650 issued to Nakajima et al (hereafter Nakajima).

Claims 35 and 51:

Bieganski discloses the elements of claim 27 as noted above. Bieganski fails to disclose wherein the control displayed for a distinguished product group is a dragable portion of the information describing the product group, together with a destination region, and wherein the

control displayed for the distinguished product group is selected by the user by dragging the draggable portion of the information describing the product group to the destination region. Nakajima discloses wherein the control displayed for a distinguished product group is a draggable portion of the information describing the product group, together with a destination region, and wherein the control displayed for the distinguished product group is selected by the user by dragging the draggable portion of the information describing the product group to the destination region [Fig 2]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bieganski to include wherein the control displayed for a distinguished product group is a draggable portion of the information describing the product group, together with a destination region, and wherein the control displayed for the distinguished product group is selected by the user by dragging the draggable portion of the information describing the product group to the destination region as taught by Nakajima for the purpose of creating a scrap book via the drag-and-drop mechanism [step 30 in Fig 23]. The skilled artisan would have been motivated to improve the invention of Bieganski such that information can be easily inputted and outputted from a document via the drag-and-drop mechanism.

Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Bieganski and Chow as applied to claim 42 in view of US Pat No 5,897,650 (Nakajima et al), hereafter Nakajima.

Claim 44:

The combination of Bieganski and Chow discloses the elements of the claimed invention as noted above but does not disclose wherein the control displayed for a distinguished product

group is a draggable portion of the information describing the product group, together with a destination region, and wherein the control displayed for the distinguished product group is selected by the user by dragging the draggable portion of the information describing the product group to the destination region. Nakajima discloses wherein the control displayed for a distinguished product group is a draggable portion of the information describing the product group, together with a destination region, and wherein the control displayed for the distinguished product group is selected by the user by dragging the draggable portion of the information describing the product group to the destination region [Fig 2]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination of references to include wherein the control displayed for a distinguished product group is a draggable portion of the information describing the product group, together with a destination region, and wherein the control displayed for the distinguished product group is selected by the user by dragging the draggable portion of the information describing the product group to the destination region as taught by Nakajima for the purpose of creating a scrap book via the drag-and-drop mechanism [step 30 in Fig 23]. The skilled artisan would have been motivated to improve the invention of the above combination of references such that information can be easily inputted and outputted from a document via the drag-and-drop mechanism.

#### **(10) Response to Argument**

**Appellant Argues:**

Appellant states in page 6, and the second paragraph that “Bieganski does not disclose “generating a list of recommended items each based on the selected seed items.”

**Examiner Responds:**

Examiner is not persuaded. In addition to the cited portions of the disclosure of Bieganski in above Office action, Bieganski teaches in column 8, lines 22-37, the following which anticipates above claim limitation:

The historical set may also include any other set of data that represents information about the user’s possession of and preference for items before the present interaction with the system. Historical data may, for example, include data gathered from credit cards, marketing surveys, and other commercially available sources of individualized preference data. For example, a store that sells film and batteries may use the historical set to store the types of cameras owned by the user, since they may help predict which film and batteries to recommend. A grocery store may record the type of milk purchases, since a customer who regularly purchases whole milk may not value a recommendation for skim milk. A bookstore may record a list of books purchased by the customer to allow it to recommend sequels to books already purchased and to avoid recommending books that are incompatible with the one already owned.

Bieganski anticipates the claimed “selected seed items” because Bieganski teaches:

- (1) historical data
- (2) record of the type of milk purchases
- (3) record of a list of books purchased by a customer

Bieganski anticipates the claimed “list of recommended items” because Bieganski teaches:

- (1) recommending film and batteries
- (2) recommending sequels to books

Bieganski discloses the following in column 7, line 65 through column 8, line 15:

A shopping set 202 includes items for which the user has indicated a current intent to purchase or consume. The user's indication may be explicitly declared or inferred from user actions. Examples of ways that a shopping set can be generated include, but are not limited to: using the contents of a "market basket" from an Internet-based shopping service; using an active shopping cart that scans the bar codes of products being placed in the basket; using the set of items entered into a cash register at check-out time; and using a shopping list provided by the customer. A shopping set may also be generated by observing the customer's behavior. It is advantageous to use a shopping set when the value of recommendations provided to the user can be increased based on their compatibility with products currently being purchased. Hence, a cooking store might use the shopping set at check-out to identify items for suggestive selling, such as a Chinese cookbook for customers purchasing a Wok.

Bieganski anticipates the claimed "selected seed items" because Bieganski teaches:

- (1) a market basket from an Internet-based shopping service
- (2) an active shopping cart that scans the bar-codes of products being placed in the basket
- (3) the set of items entered into a cash register at check-out time
- (4) a shopping list provided by a customer
- (5) shopping set may be generated by observing the customer's behavior.

Bieganski anticipates the claimed generating a list of recommended items because Bieganski teaches:

- (1) recommendations provided to the user
- (2) suggestive selling

Bieganski discloses the following in column 10, lines 35-50:

The compatibility modifier 200 accepts as inputs the recommendation set 201, the compatibility rules 204, and, optionally, the shopping set 202 and/or the history set 203. The compatibility modifier 200 applies the compatibility rules 204 to the recommendation set 201, optionally using the shopping and historical sets 202 and 203, to produce a modified recommendation set. In this embodiment of the invention, the compatibility modifier 200 executes as a process on the

computer system, for example computer system as shown in FIG. 1, on one or more processors. The compatibility modifier 200 implements a modification algorithm, which is an algorithmic process that applies the rules and generates the modified recommendation set.

Bieganski anticipates the claimed “selected seed items” because Bieganski teaches:

- (1) shopping set 202 and/or history set 203

Bieganski anticipates the claimed “generating a list of recommended items because Bieganski teaches:

- (1) recommendation set 201

**Applicant Argues:**

Applicant states in the third paragraph of page 9 “Nakajima, cited by the examiner for teaching draggable controls, describes a document scrap system in which a user selects a portion of a document to create a document scrap for incorporation into other documents. It is unclear how it would be possible to combine the system of Nakajima with Bieganski to produce the aspects of applicant’s technology described by the claim. Bieganski does not describe dragging at all, and Nakajima only describes dragging portions of documents to the desktop for later reuse in other documents. The control recited by applicant’s claims is for selecting recommendation seeds. There is no teaching or suggestion with either Bieganski or Nakajima to combine these references in any way, much less to produce applicant’s invention. Accordingly, applicant respectfully requests that these rejections be withdrawn.

**Examiner Responds:**

Examiner is not persuaded. If appellant argues that there is no specific suggestion or teaching in the references to combine prior art, the examiner may respond that KSR forecloses the argument that a specific teaching, suggestion or motivation is required to support a finding of obviousness. See the recent Board decision *Ex parte Smith* –USPQ2d--, slip op. at 20, (Bd. Pat App. & Interf. June 25, 2007) (citing KSR, 82 USPQ2d at 1396) (available at [uspto.gov/web/offices/dcom/bpai/prec/fd071925.pdf](http://uspto.gov/web/offices/dcom/bpai/prec/fd071925.pdf))

Examiner maintains that dragging is well-known and expected in the art. The Microsoft Computer Dictionary, Fifth Edition defines dragging as the following:  
In graphical user interface environments, to move an image or window from one place on the screen to another by “grabbing” it and pulling it to its new location using the mouse. The mouse pointer is positioned over the object, and the mouse button is pressed and held while the mouse is moved to the new location.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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